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In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 CFR 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his-her answers to questions 1, 8 and 32 of the morning section and questions 11, 12 and 22 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 26, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 1, 8 and 32 and afternoon questions 11, 12 and 22. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:
1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

(A) dot matrix printer for printing indicia on a first surface of a label.

(B) dot matrix printer means coupled to a computer.

(C) means for printing indicia on a first surface of a label.

(D) printer station for printing indicia on a first surface of a label.

(E) All of the above.

1. The model answer: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase "means for", (2) the "means for" must be modified by functional language, and (3) the "means for" must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase "means for" and recites structure for achieving the specified function ("printer"). (B) is wrong because it modifies the "means" with structure, and also fails to modify the "means" with functional language. (D) is wrong because it does not use the phrase "means for" and also recites structure modifying "mechanism."

Petitioner argues that answer (B) is correct. Petitioner contends that the model answer does not follow MPEP 2181, as it provides that "means for" language does not automatically make a limitation subject to Section 112, paragraph 6 interpretation. Petitioner argues that one would need more information to answer the question and states "there is insufficient information provided in order to determine whether any of the answers other than Answer C recite a claim limitation within Section 112, paragraph 6".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that there is insufficient information provided to determine the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6. The use of "means for" language is the best way to insure a claim limitation will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6. The question is not whether any other answers other than Answer C, as urged by Petitioner, it is what choice is the best answer. "There is insufficient information provided in order to determine whether any of the answers other than Answer C recite a claim limitation within Section 112, paragraph 6". Accordingly, model answer C is correct and petitioner's answer B is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:
8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). ~~Also, evidence or common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (B) is also correct. Petitioner contends that the fact pattern fails to provide the subsections under 102 for the 103 rejection and the date for which the

Smith reference is available as prior art and, absent an unwarranted assumption, the Smith reference may not have been antedated by the affidavit, making selection (D) not in accord and therefore an equally correct response.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the fact pattern fails to provide the date for which the Smith reference is available as prior art and, absent an unwarranted assumption, the Smith reference may not have been antedated by the affidavit, making selection (D) not in accord and therefore an equally correct response, it would be sufficient to negate the Jones reference as prior art without negating the Smith reference to overcome the rejection. A rejection under 35 USC 103 requires all the elements in the claims to be found in the prior art. Negating the application of art to some elements overcomes the rejection as to those elements. Therefore, selection (B) is in accord and therefore an incorrect response. Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:
32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

(A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.

(B) James can be named as a co-inventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.

(C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.

(D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.

(E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

32. The model answer: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered co-inventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

Petitioner argues that answer (D) is also correct. Petitioner contends that the fact that it took only a matter of seconds is indicative of obviousness. Petitioner further argues that the model answer provided states that James was not one of ordinary skill in the art, any consideration of utilizing 35 USC 103 should be null and void.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the fact that it took only a matter of seconds is indicative of obviousness, and in the alternative, his answer should receive credit because of flaws in the selection, his conclusions are inaccurate. As to the speed with which James thought of the microwave oven use, this is not the test for obviousness, rather the closest art is the test, and the fact pattern provides no art upon which a conclusion of obviousness could be made. The question is based on the facts as presented, while James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. James level of skill was not discussed in the question, nor was it provided in the model answer. The question does not state that Johnnie and James will receive a patent and it does not discuss the prior art. Answer (B) provides that Johnnie and James could be named as co-inventors on a patent application, which is true. Accordingly, model answer (B) is correct, and the petitioner's answer (D), is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 11 reads as follows:
11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

(A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.

(B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.

(C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.

(D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.

(E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

11. The model answer: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7).

Petitioner argues that answer (E) is correct. Petitioner contends that the applicant cannot claim priority to claimed subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect. Petitioner also argues that the model answer improperly adopts a position the invention is about two separate elements, not the combination of the two elements., thus (E) is the only remaining correct selection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the applicant cannot claim priority to claimed subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect, and (E) is the only remaining correct selection, a nonprovisional application may claim the benefit of the filing date of an earlier-filed provisional application for the subject matter disclosed in the provisional application. Henrietta's provisional application provides support for a camera that can operate at high temperature. Furthermore, answer (A) is correct because Henrietta would obtain the broadest patent protection, covering both aspects of her invention, a camera that can operate at high temperature and is waterproof. Answer (E) is incorrect because Henrietta would not obtain patent protection for the means that fix the leakage issue. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.
Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:
12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

(A) Barry's device is too large to combine with Lance's device.

(B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor that the applicant's invention.

(C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.

(D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.

(E) All of the above.

12. The model answer: (C) is correct. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance's device unsatisfactory for its intended purpose. (A) is incorrect. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference .... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. "'In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.'" MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry's art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that the question is vague and answer (B) could be correct because the Barry reference is nonanalogous art, because, it relates to a different field of endeavor than the applicant's invention. Petitioner argues that question only asks one to pick an argument that could properly over come the reject, not shall overcome the rejection. Petitioner argues that it is possible that (B) could properly answer the question.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (B) could be the correct answer and that the question is which answer could be a possible answer and thus (B) is a correct answer. Test takers are supposed to pick the best answer. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. Answer (C) is the correct because an argument that the combination of references would have precluded Lance's device from performing as Lance intended could properly overcome a 103 rejection. An argument that the Barry reference is nonanalogous art, because it relates to a different field of endeavor that the applicant's invention would not overcome a 103 rejection when the reference is also pertinent to the particular problem with which Lance was concerned. Accordingly, model answer C is correct and petitioner's answer B is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 22 reads as follows:
22. Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USTPO practice and procedure?

(A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.

(B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.

(C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.

(D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.

(E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

22. The model answer: (E) is the correct answer. 35 U.S.C. § 251. The reissue permits Smarter to broaden the claimed subject. (A) is incorrect. There must be copendency between the divisional application and the original application. 35 U.S.C. § 120. (B) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *In re Orit*a, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (C) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, Id., including a divisional reissue application. MPEP § 1402. (D) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, Id.

Petitioner argues that answer (A) is correct. Petitioner argues that no answer is correct, and therefore credit should be granted for all answers, including Petitioner's answer (A). Petitioner contends that the model answer (E) is incorrect because there is no indication that Smarter's narrow claim coverage resulted from error.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the model answer (E) is incorrect because there is no indication that Smarter's narrow claim coverage resulted from error, the fact pattern specifies that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. This clearly implies that Smart failed to appreciate the breadth of subject matter to which he was entitled to claim, which is an error ("or by reason of the patentee claiming more or less then he had a right to claim in the patent") of which 35 U.S.C. § 251 can be invoked for a reissue application. Failure to appreciate the full scope of the invention was held to be an error correctable through reissue in In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.
Petitioner contends that

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy